

REMARKS

Applicant has received and carefully reviewed the Final Office Action of the Examiner mailed September 12, 2006. Currently, claims 13 and 15-20 remain pending. Claims 13 and 15-17 have been rejected. Favorable consideration of the following remarks is respectfully requested.

Claims 13 and 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Alchas (US Patent No. 5,030,210) in view of Person et al. (US Patent No. 5,807,349). After careful review, Applicant respectfully disagrees.

Turning to claim 13, which recites:

13. A single lumen microcatheter, comprising:
 - an elongate shaft having a distal end and a proximal end, the elongate shaft having an outer surface and an inner surface, the inner surface defining a lumen extending through the elongate shaft;
 - an elongate guidewire port positioned proximal of the distal end of the elongate shaft, the elongate guidewire port extending from the inner surface of the elongate shaft to the outer surface of the elongate shaft; and
 - a polymer sheath disposed over the elongate guidewire port, the polymer sheath having an inner surface and an outer surface, the polymer sheath including a passage comprising an angled slit extending radially through the polymer sheath at an angle such that the slit has a depth that is greater than a thickness of the polymer sheath, *the slit disposed parallel to a longitudinal axis of the elongate shaft*, the passage in communication with the elongate guidewire port, wherein the passage is configured to permit guidewire access through the elongate guidewire port while remaining substantially fluid tight in use when no guidewire is provided through the passage. (Emphasis added.)

The Final Office Action states that Alchas in view of Person discloses the claimed invention except for the slit parallel along the longitudinal axis and that it would have been an obvious matter of design choice to position the slit parallel along the longitudinal axis, since Applicant has not disclosed that the parallel slit over the angled slit solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well.

After careful review, Applicant believes that it would not have been an obvious matter of design choice to position the slit of Person et al. parallel along the longitudinal axis. In order to establish a *prima facie* case of obviousness, there must be at least some suggestion or motivation to modify the references or to combine the reference teachings. (See MPEP § 2142). Furthermore, a prior art reference must be considered in its entirety, i.e., as a whole, including portions

that would lead away from the claimed invention. (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983)). Applicant believes that, as a whole, the teachings of Alchas in view of Persons et al. do not provide suggestion or motivation to modify the references.

In fact, not only do Person et al. not teach or suggest a parallel slit along the longitudinal axis, but Person et al. teach away from using a slit parallel to the longitudinal axis rendering it not an obvious design choice. Person et al. recite:

FIGS. 1 and 2 show the valve 22 oriented at an angle to the longitudinal axis of catheter 10. Thus, valve 22 lies in a plane oriented at an angle to the longitudinal axis. *Positioning the valve 22 at an angle within the reduced wall thickness results in a larger opening for the ingress and egress of fluids. When suction is applied, the reduced thickness wall will want to collapse so it will twist. Thus the slit opens into an eye-shaped opening as shown for example in FIG. 18A. A preferred angular orientation of valve 22 relative to the longitudinal axis is 30 degrees, although differing angles, and particularly greater angles, will provide the desired advantage.* (Column 4, lines 6-17.) (Emphasis added.)

As can be clearly seen, Person et al. teach the use of an angled slit and not a slit parallel to the longitudinal axis and thus teach away from using a slit parallel to the longitudinal axis. Therefore, there is no motivation for a person of ordinary skill in the art to modify the teachings of Person et al. in order to arrive at the claimed invention having “the slit disposed parallel to a longitudinal axis of the elongate shaft”, as recited in claim 13.

Additionally, the Examiner states in the Final Office Action that in the alternative, one of skill in the art would have made a modification to make the slit parallel to the longitudinal axis because it would be an obvious modification and it has been held that rearranging parts of an invention involves only routine skill in the art (*In re Japikse*, 86 USPQ CCPA 1950), and the mere reversal of the essential working parts of a device involves only routine skill in the art (*In re Einstein*, 8 USPQ 167). Applicant respectfully disagrees.

However, the rearrangement of part may involve only routine skill in the art when there is no modification in the operation of the device (*In re Japikse*, 86 USPQ CCPA 1950, (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because *shifting the position of the starting switch would not have modified the operation of the device.*)). As can be clearly seen from the excerpt of Person et al provided above, there is a modification in the operation of the device when the

orientation of the slit is changed. Accordingly, this change in orientation is not a mere rearrangement of parts that involves only routine skill in the art.

Furthermore, the mere fact that a person of skill in the art could rearrange the parts of the references to meet the terms of the claims is not itself sufficient to establish a *prima facie* case of obviousness. The prior art must provide a motivation or reason, without the benefit of the present specification, to make the modifications of the reference device." (*Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353; *See* MPEP 2144.04). As discussed previously, it is believed that there is no motivation to modify the teaching of Person et al. to have a parallel slot because Person et al. teaches away from a parallel slot.

Therefore, for at least the reasons given above, it is believed that claim 13 is allowable over Alchas in view of Person et al., and Applicant respectfully requests withdrawal of the rejection.

Additionally, for similar reasons given above, claims 15-17, which depend from claim 13 and include significant additional limitations, are believed to be allowable over Alchas in view of Person et al., and Applicant respectfully requests withdrawal of the rejection.

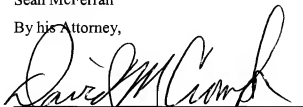
Finally, Applicant thanks the Examiner for indicating that claims 18-20 are allowable over the prior art of record.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,



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Date: 11/13/06